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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,258

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Michael John Radley Young

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12/05/2007

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EXAMINER

ROZANSKI, MICHAEL T

ART UNIT

PAPER NUMBER

3768

MAIL DATE

DELIVERY MODE

12/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,258

Applicant(s)

YOUNG ET AL.

Examiner

Michael Rozanski

Art Unit

3768

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Objections

Claim 1 is objected to because of the following informalities: The term "whereby" should be changed to "wherein" to positively claim the limitation that follows the term. Appropriate correction is required.

Double Patenting

Claims 1, 3-4, 9-14, and 20-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claims 1-2, 5-10, and 14-19 of copending Application No. 10/399,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than those of the '664 application. Therefore, any surgical tool meeting the limitation of the '664 application would necessarily meet those of the instant application, as well. Furthermore, claim 15 of the copending application refers to generation of torsional vibrations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (US 5,873,873) in view of Wuchinich (US 6,984,220).

Claims 1-22: Smith et al disclose an ultrasonic surgical clamp coagulator apparatus for coagulating and/or cutting tissue (col. 1, lines 7-12). The tool includes a 1st jaw member 180', a pivotally movable 2nd jaw member 191 at a distal end that pivots around a first axis and an axis orthogonal thereto, a longitudinally extending carrier means 170 rotatable about a waveguide 180 that is connected at a proximal end to generate ultrasonic vibrations, outer shroud means 160 including operating means for the 2nd jaw member whereby rotation of the carrier means acts on the operating means to cause pivoting of the 2nd jaw member into and out of operative relationship with the 1st jaw member (see figure 4; col. 10, lines 20-62). Rotation is caused by a rotation knob 216 mounted on the outer tubular sheath (col. 12, lines 49-58). The carrier tube 170 is rotatable within a tubular space defined by an inner wall of the outer shroud tube, which is detachably mounted non-rotatably to a manually operated control means with handset of the tool (col. 12, line 49-col. 13, line 5), and an outer surface of the inner

guide member (see figure 4). A pair of lever portions 193 extending proximally are positioned on opposite sides of the waveguide 180 and are in operable engagement with a drive portion 194 of the reciprocable actuating member 170 (col. 10, lines 46-62). A proximally facing surface of the 2nd jaw comprises a curved zone between two protrusions, wherein rotational movement of a protrusion of one or more guide lobes acts to pivot the 2nd jaw into and out of operative relationship with the 1st jaw (see figure 10; col. 10, lines 46-62). The 2nd jaw is caused to pivot relatively slowly over a coagulation step and relatively rapid over a cutting step and moves between open and closed dispositions by a rotational movement of the carrier means via resilient biasing means (col. 13, lines 6-27).

Furthermore, the 2nd jaw follows a three dimensional path when moved, as described with rotational and longitudinal movement above.

Smith et al also teach that a torque can be applied by a suitable torque wrench or the like to permit the waveguide, which is connected to the ultrasonic drive unit 50 and the elongated portion 150, to be rotatable (col. 13, line 64-col. 14, lines 12). In the same field of endeavor, Wuchinich teaches an apparatus that provides simultaneous longitudinal and torsional ultrasonic vibrations for dissecting biological tissue (col 2, lines 59-64). It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Smith et al to substitute the waveguide and end effector with a longitudinal torsional assembly, as taught by Wuchinich, because the simultaneous vibrations would allow rapid, precise removal of tissue normally resistant to ultrasonic dissection. Further, instruments that incorporate rotation into the tip (i.e.

Smith et al) often require rotating seals and bearings making them complicated in construction, expensive to manufacture, and fragile in use (col 1, lines 46-54).

Response to Arguments

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

In addition, the double patenting rejection is maintained. Although the current application does not specifically claim the two protrusions as claimed in copending application 10/399,664, this limitation is not patentably distinct from the structural limitations of the current invention. Although the copending application includes a narrower limitation with regard to certain structure, this is not sufficient to recite structure than is patentably distinct from the limitations of the current invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schulze et al (US 5,669,544) teach of rotating a closure tube 838 for actuating jaws (col 22, lines 45-55).

Applicant's amendment filed 7/16/07 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Rozanski whose telephone number is 571-272-1648. The examiner can normally be reached on Monday - Friday, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MR


ERIC F. WINAKUR
PRIMARY EXAMINER